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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,227	06/26/2003	William E. Spindler	NSC0001	5896
832	7590	12/19/2007	EXAMINER	
BAKER & DANIELS LLP 111 E. WAYNE STREET SUITE 800 FORT WAYNE, IN 46802			CARRILLO, BIBI SHARIDAN	
			ART UNIT	PAPER NUMBER
			1792	
			MAIL DATE	DELIVERY MODE
			12/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,227

Applicant(s)

SPINDLER, WILLIAM E.

Examiner

Sharidan Carrillo

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 37-80 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for cleaning a food processing environment, does not reasonably provide enablement for cleaning a surface or an item of equipment . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims embrace an invention which contains any known item or equipment, which could/can be selected from literally thousands (i.e. tile, ceramic, glass, metal, plastic, wood). It does not appear to be feasible that any item or surface would function in the present invention. Further, for one skilled in the art to reproduce the present invention (which must be possible, if the specification is adequate), there would clearly be undue experimentation to do so in an attempt to figure out which ones work and which ones do not.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 47-52, 56, 58, 62-67, 70, and 73,-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites the language of "consisting essentially of", which is closed language. However, claim 47, which is dependent on claim 37 recites includes" which is open-ended. The dependent claim is indefinite because it recites open-ended language, but is dependent on an independent claim, which recites closed language. Claims 48, 56, 58, 62-63, 70, 73-74 and 79 are indefinite because of similar reasons. Additionally, claims 50, 56, 65, 70, and 79 recite the open ended language of comprising.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 37-51, 53-66, 68-77, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Arbogast et al. (5739327).

Re claims 37-40, 57-59 and 71, Arbogast teach a method of cleaning hard

surfaces comprising a first chamber comprising hydrogen peroxide and a second chamber comprising an alkaline solution sufficient to maintain the pH to greater than about 8, in the range of 8.5 to 10.5 (col. 9, lines 15-65). Applicant's claim language of "consisting essentially of" does not overcome the teachings of the reference because applicant has not submitted factual evidence to show that the nitrile activator of Arbogast does not materially affect the basic and novel characteristics of applicant's claimed invention. The burden rests on applicant to establish that the nitrile activator of Arbogast does not materially affect the basic and novel characteristics of applicant's claimed invention. Arbogast teaches the components in a liquid or solid matrix (col. 9, lines 20-25, lines 63-68, Example 7 teaches granular compositions. Re claims 41-44, the limitations are inherently met since Arbogast teach the claimed surfactants. Re claim 45, col. 6, lines 60-63, col. 8, lines 59-60. Re claim 46, the limitations are inherently met since col. 9, lines 5-9 teaches the pH maintained in the acidic range. Re claims 47-51, 62-66, 73-77, refer to col. 8, lines 7-45. Re claims 53-54, 56, 68, 70, 79, refer to col. 8, lines 60-65. Re claims 55, 69, refer to col. 9, lines 10-15. Re claim 60, refer to col. 9, lines 45-47. Re claim 61; refer to col. 9, lines 60-65. Re claim 72, refer to col. 9, lines 50-54.

7. Claims 37-47, and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Rees (5743514).

Rees teaches a method of cleaning a hard surface comprising a first vessel comprising peroxide and a second vessel comprising an alkaline agent (col. 6, lines 10-15) to raise the pH within the range of from 7-13 (claim 18). Re claim 38, refer to col. 2-

3 bridging. Re claim 39, refer to col. 3, lines 20-22. Applicant's claim language of "consisting essentially of" does not overcome the teachings of the reference because applicant has not submitted factual evidence to show that the lactones of Rees do not materially affect the basic and novel characteristics of applicant's claimed invention. The burden rests on applicant to establish that the lactones of Rees do not materially affect the basic and novel characteristics of applicant's claimed invention. Re claim 40, refer to col. 3, lines 25-31. Re claims 41-44, the limitations are inherently met since Rees teaches the addition of surfactants of the cleaning solution. Re claim 45, refer to col. 4, lines 30-35. Re claim 46, refer to col. 3, lines 25-27. Re claim 47, refer to col. 5, lines 65-66. Re claim 53, see col. 11, lines 30-32. Re claim 54, col. 5, lines 50-53. Re claim 55, refer to claim 18.

8. Claims 37-51 and 53-56 rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (6391840).

Re claims 37, 39, Thompson et al. teach a composition for cleaning and disinfecting surfaces. Col. 4-5 bridging teaches a two chamber container comprising a) hydrogen peroxide in first chamber and an alkali component in a second chamber, the alkali component raising the pH of the solution to a pH of 11 (col. 14, lines 1-25). Applicant's claim language of "consisting essentially of" does not overcome the teachings of the reference because applicant has not submitted factual evidence to show that the imines or oxaziridines of Thompson do not materially affect the basic and novel characteristics of applicant's claimed invention. The burden rests on applicant to establish that the imines or oxaziridines of Thompson do not materially affect the basic

and novel characteristics of applicant's claimed invention. Re claim 38, refer to col. 12, lines 7-15. Re claims 40-44, refer to col. 5, lines 5-25. Re claim 45, refer to col. 5, lines 50-55. Re claim 46, refer to col. 5, lines 60-63, col. 14, Example 2. Re claims 47-51, col. 9-col. 10. Re claim 53, example 2. Re claim 54, col. 2, lines 50-51. Re claim 55, col. 12, lines 5-15. Re claim 56, col. 9, lines 30-33, lines 55-60, col. 5, lines 50-56, col. 2, lines 45-54.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 52, 67, 78, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arbogast et al. (5739327).

Arbogast et al. teach the invention substantially as claimed with the exception of the diphenyl sulfonate. However, it would have been within the level of the skilled artisan to have modified the method of Arbogast to include diphenyl sulfonates since Arbogast teaches that anionic surfactants include sulfonates and linear and branched benzene sulfonates. Arbogast fails to teach the size of the container. However, it would have been well within the level of the skilled artisan to adjust the size of the container depending upon the surface area of the substrate to be cleaned. Clearly, a larger container would be advantageous for cleaning larger surface areas. Changes in size of an article were held to be obvious. In re Rose 105 USPQ 237 (CCPA 1955).

12. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (6391840).

Thompson et al. teach the invention substantially as claimed with the exception of the diphenyl sulfonate. However, it would have been within the level of the skilled artisan to have modified the method of Thompson to include diphenyl sulfonates since

Thompson teaches that anionic surfactants include sulfonates and linear and branched benzene sulfonates.

Response to Arguments

13. The rejection of the claims, under 112, second paragraph, is maintained for the reasons set forth above. Applicant argues that the "consisting essentially of" language is partially open ended language, occupying a middle ground between "comprising" and "consisting". Applicant's arguments are unpersuasive since "consisting essentially of" is construed as equivalent to "comprising" (i.e. open-ended language) **only** for the purpose of searching for and applying prior art under 35 U.S.C. 102 and 103. The issue at hand is not a prior art rejection, but a 112, second paragraph issue. By using the term 'consisting essentially of,' the drafter signals that the invention necessarily includes the listed ingredients and is **open** to unlisted ingredients that do not materially affect the basic and novel properties of the invention (MPEP 2163, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448). Therefore, the claim is closed or excluded from those ingredients that materially affect the basic and novel properties of the invention.

14. The rejection of the claims, under 112, first paragraph, enablement is maintained for the following reasons. Applicant argues that pages 1, 2, and 6 are directed to cleaning surfaces or equipment. However, applicant's citations are all directed to cleaning surfaces of a food processing environment. The entire specification, including the title, is directed to cleaning surfaces of a food processing environment and not just any surface or item of equipment. The claims embrace an invention which contains any known item or equipment, which could/can be selected from literally thousands (i.e.

tile, ceramic, glass, metal, plastic, wood). It does not appear to be feasible that any item or surface would function in the present invention. Further, for one skilled in the art to reproduce the present invention (which must be possible, if the specification is adequate), there would clearly be undue experimentation to do so in an attempt to figure out which ones work and which ones do not. As such, the claims should be limited to food processing equipment surfaces.

15. Applicant argues that since the claims are amended to include "consisting essentially of" language, the rejections of the claims as being anticipated or unpatentable by Arbogast, Rees, or Thompson should be withdrawn. Applicant has not shown whether the nitrile activator, lactones, or imines of the prior art of Arbogast, Rees, and Thompson, materially affect the basic and novel characteristics of the claimed invention. If applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd.Pat. App. & Inter. 1989) (MPEP 2111.02).

16. Applicant's submits a 1.132 Declaration to overcome the 102b rejections of Arbogast, Rees, and Thompson. The 102(b) creates a statutory bar and a 1.132 Declaration will not overcome the statutory bar rejections (MPEP 2136.05,706.02 b). Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection

so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973) (MPEP 2131.04). Furthermore, even if the claims were obvious over the prior art of Arbogast, Rees, and Thompson, the Declaration would not be persuasive since Applicant's declaration are conclusory statements not supported by factual evidence, see *In re Lindner*, 457 F.2d 506, 173 USPQ 356 (CCPA 1972)." . If applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd.Pat. App. & Inter. 1989) (MPEP 2111.02). Applicant has not provided convincing evidence to compare applicant's invention prior to the addition of the nitrile activator, lactone, and imine and applicant's invention after the addition of nitrile activator, lactone, and the imine and whether the additional prior art components materially affect the basic and novel characteristics of applicant's claimed invention. Specifically, applicant's declaration is not commensurate in scope with applicant's claimed invention.

17. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/07 has been entered.

18. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on M-W 6:30-4:00pm, alternating Thursday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Sharidan Carrillo
Primary Examiner
Art Unit 1792

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER